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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,148	02/24/2004	Kenneth R. Cooper	618-1185-999	8151
20583	7590	04/22/2005	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			WALCZAK, DAVID J	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,148

Applicant(s)

COOPER ET AL.

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Izushima. In regard to claims 1 and 13, Izushima discloses an elastomeric gripping element 28 (see Figure 4) configured to fit over a gripping section of an article wherein the gripping element comprises a cylindrical member (i.e., "means for gripping an article") having an outer surface, a plurality of elevated sections 28a (i.e., "means for enhancing the grip of the article") extending from the outer surface wherein the elevated sections are intercalated, spaced apart shapes and a band member (viewing Figure 4, the enlarged projection on the grip closest to the tip 22) situated between the cylindrical member and a writing nib 22 wherein the band member has a diameter greater than the diameter of the cylindrical member. In regard to claims 4-8, the element is formed from an anti-slip, resilient thermoplastic elastomer (column 3, lines 15-16) having the claimed hardness (column 3, lines 22-24). In regard to claim 9, the elevated sections are spaced such that "small" particles will not become lodged therebetween and a

particle which is large enough to become lodged can be "readily" dislodged. In regard to claim 10, the elevated sections have a smooth surface. In regard to claim 13,

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Izushima. In regard to claims 2 and 3, although the Izushima reference does not disclose the height of the elevated sections, the Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the elevated sections can be designed to have any suitable height, including the claimed height, without effecting the overall operation of the device. Further, given the gripping element in the Izushima reference is for a writing instrument (as is the Applicant's), it appears that the claimed height of the elevated sections is well within the realm of obviousness to one of ordinary skill in the art. It is noted that since this rejection has not been seasonably challenged by the Applicant, the claimed feature is now considered to be admitted prior art, see MPEP 2144.03, section C.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broschart in view of Izushima. Broschart discloses an elastomeric gripping

element comprised of a cylindrical member 2a, a conical member 3 which converges toward a writing nib, and a band member (the portion 4 adjacent the member 3) between the conical member and cylindrical member wherein the members are made of the same material. Although the Broschart device does not include intercalated elevated sections thereon, attention is directed to the Izushima reference which discloses another elastomeric grip wherein such elevated sections 28a are present thereon in order to enhance the grip of the user. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such sections onto the Broschart device in order to enhance the gripping effects for a user.

Response to Arguments

Applicant's arguments filed 2/23/05 have been fully considered but they are not persuasive. The Applicant contends that the Izushima reference is not applicable against claim 1 in that it does not disclose the claimed band. However, as discussed in detail above, the Izushima reference does disclose the claimed structure. In regard to claim 13, the Applicant contends that the cylindrical portion of the instant invention may define the "means for gripping" and the "means for enhancing the grip" are defined by the elevated sections. As the Izushima reference discloses both a cylindrical section and elevated sections (as discussed supra), Izushima anticipates claim 13.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
4/19/05